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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,032	09/20/2001	Alan J. Lang	D-2821CON	6533

7590 11/04/2002

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EXAMINER

CHATTOPADHYAY, URMI

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 09/960,032	Applicant(s) LANG, ALAN J.	
	Examiner Urmi Chattopadhyay	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2,4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Preliminary Amendment filed has been entered as Paper No. 3. Changes to the specification have been approved by the Examiner, claims 1-25 have been canceled and new claims 26-45 have been added.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 26-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Portney (USPN 6,197,058 as cited in applicant's IDS).

Portney discloses an intraocular lens for use in a mammalian eye having a natural lens with accommodative capability with all the elements of claims 26 and 37. See Figure 1b and 3.

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The multifocal lens (column 10, lines 21-23) has a baseline optical power (column 3, lines 15-16) and at least one optical add power (column 3, lines 22-25). Thus, the at least one optical add power of the IOL is deemed to have “a maximum add power less than the optical power required for full near vision correction”, as clearly established in column 7, lines 1-2. Also see column 7, lines 18-21, i.e., *“Thus, for whatever reason, the initially selected power of implanted IOL may not initially...provide the optimum vision or intended vision correction for the patient.”* Hence, in situ correction of the power of an already implanted IOL (e.g., spherical power, cylinder power and/or *add* power) is enhanced by implanting a secondary IOL configured to correct the primary IOL (e.g., spherical power, cylinder power, and/or *add* power) as clearly established in column 7, lines 30-31 and 40-58.

Claims 27, 32, 38 and 43, see column 3, lines 15-19 and 22-25 for lens body (system of primary IOL and secondary IOL) having a plurality of regions for near vision.

Claims 28-31 and 39-42, see columns 6-7, lines 65-2 and column 7, lines 40-57 for optical add power being reduced by a certain percentage. It is inherent that these reduced percentages are met the invention of Portney to meet the needs of the individual patient, as determined by an ophthalmologist.

Claims 33 and 44, see Figures 2 and 3, element 72, for fixation member.

Claims 34 and 35, see Figures 1a and 1b, column 3, lines 61-64 for lens body being used in the anterior chamber and in the posterior chamber of the eye.

Claims 36 and 45, see columns 2-3, lines 65-4 for lens body being deformable for insertion through a small incision into the eye.

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4. Claims 26-32 and 37-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Menezes et al. (USPN 5,847,802 as cited in applicant's IDS).

Menezes et al. discloses a multifocal intraocular lens (column 1, lines 22-25 and Figure 1) for use in an eye having a natural lens (column 4, lines 52-53, wherein the statement that "*Some patients may not require the full...add power in these designs.*" clearly suggests use with the natural lens of the eye, otherwise full add power correction would be necessary for full near vision). The lens has a baseline optical power (12) and at least one optical add power (14) (column 3, lines 62-65 and column 4, lines 19-24). Menezes et al further discloses that when full add power is not required, the near power can be made a fraction (preferably 50%) of the full add power (column 4, lines 52-55). Thus, since the at least one optical add power of the IOL is made to be a fraction of the full add power, the at least one optical add power is deemed to have "a maximum add power less than the optical power required for full near vision correction" (claims 26 and 37).

Claims 27, 32, 38 and 43, see column 3, lines 13-19 and 62-65 for plurality of regions for enhancing near vision.

Claims 28-31 and 39-42, see column 4, lines 52-57 for the optical add power being reduced by at least a certain percentage.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 33-36, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menezes et al. in view of Portney.

Menezes et al. discloses an intraocular with all the elements of claims 26 and 37, but is silent to the additional limitation of a fixation member coupled to the lens body, as required by claims 33 and 44. Portney teaches an IOL with a fixation member in order to attach the IOL to the eye, as shown in Figure 3. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to look to the teachings of Portney to modify the IOL of Menezes et al. to include a fixation member in order to attach the IOL to the eye. Menezes et al. is also silent to the limitations of the lens and fixation member being adapted to be placed in the anterior and posterior chambers of the eye, as required by claims 34 and 35. Portney teaches placing the lens and fixation members in these chambers in order for the lens to function as an IOL. See column 3, lines 61-64. It would have been obvious to one of ordinary skill in the art to place the lens and fixation member the anterior and posterior chambers of the eye if the lens of Menezes et al. is to be used as an intraocular lens. Portney also teaches the additional limitations required by claims 36 and 45 of the lens being deformable in order to minimize the size of the incision. See column 3, lines 1-4. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to look to the teachings of Portney to modify the IOL of Menezes et al. to make the lens deformable in to minimize the size of the incision.

Double Patenting

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and

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useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 26-32 and 37-43 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 26-39 of copending Application No. 09/302,977. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 26, 27, 32-38, 43-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 6, 8, 10, 12-14, 17, 19, 21 of copending Application No. 09/302,977, claims 1, 9, 15, 19 of copending Application No. 09/565,036, claims 1, 11, 14, 19, 26, 30 of copending Application No. 09/564,317, and claims 1, 14, 24, 26 of copending Application No. 09/564,123. Although the conflicting claims are not identical, they are not patentably distinct from each other because

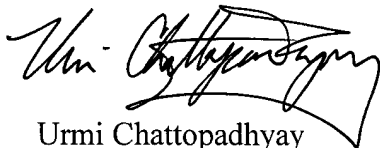
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these copending applications each claim a lens for implantation in an eye, hence an intraocular lens, having a multifocal lens body having a maximum optical add power less than the optical add power required for full near vision correction. Because the claims of the current invention are broader than those of the cited copending applications, the obviousness-type double patenting is warranted.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

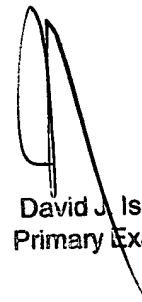
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Urmi Chattopadhyay whose telephone number is (703) 308-8510 and whose work schedule is Monday-Friday, 9:00am – 6:30pm with every other Friday off. The examiner's supervisor, Corrine McDermott, may be reached at (703) 308-2111. The group receptionist may be reached at (703) 308-0858.

Should the applicant wish to send a fax for official entry into the file wrapper the Group fax number is (703) 305-3590. Should applicant wish to send a fax for discussion purposes only, the art unit fax number is (703) 308-2708.



Urmi Chattopadhyay

Art Unit 3738



David J. Isabella
Primary Examiner

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October 28, 2002